Applicants : Barry Appelman et al.
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Attorney's Docket No.: 06975-505001 / AOL 211

REMARKS

By this Reply, Applicants cancel claims 2, 3, 5, 6 and 78-89, without prejudice or disclaimer of the subject matter therein, amend claims 1, 4, 7-24 and 45-77, and add new claims 90-92. Applicants also amend the title. Claims 1, 4, 7-77 and 90-92 are pending in this application, with claims 1, 24, 45, 56 and 77 being independent.

In the Office Action of August 30, 2007 ("Office Action"), claims 21-23 were objected to for informalities; claims 45-76 were rejected under 35 U.S.C. § 101; claims 1, 24, 42-45 and 77 were rejected under 35 U.S.C. § 102 based on U.S. Patent No. 7,133,900 ("*Szeto*"); claims 1-12, 14, 15, 17, 18, 20-32, 34, 35, 37-41, 45-48, 50, 51, 53-64, 66, 67, 69, 71-81 and 83-89 were rejected under section 102 based on U.S. Patent No. 5,880,731 ("*Liles*"); claims 13, 16, 33, 36, 49, 52, 68 and 70 were rejected under 35 U.S.C. § 103(a) based on *Liles* in view of U.S. Patent No. 5,963,217 ("*Grayson*"); claims 19 and 82 were rejected under section 103(a) based on *Liles* in view of U.S. Patent No. 5,745,556 ("*Ronen*"); and claim 65 was rejected under section 103(a) based on *Liles* in view of U.S. Patent No. 5,944,780 ("*Chase*"). The Office Action also objected to the title. These items and the new claims are addressed below.

Regarding the title

The Office Action asserts that the title is not descriptive. *See* Office Action, p. 2. To expedite prosecution, Applicants amend the title to read --MIGRATING INSTANT MESSAGING PERSONALIZATION TO CHAT APPLICATIONS--. Applicants submit that the amended title is descriptive of what is claimed.

Objection to claims 21-23

The Office Action notes that the term "the predetermined event" in claims 21-23 lacks antecedent basis in claim 18, upon which claims 21-23 depend. *See* Office Action, p. 2. Applicants amend claims 21-23 so that each of these claims now depends upon claim 20, which provides antecedent basis for "the predetermined event." Applicants accordingly request withdrawal of the objection to dependent claims 21-23.

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Section 101 rejection of claims 45-76

According to the Office Action, claims 45-76 are directed to non-statutory subject matter. In particular, the Office Action asserts that the term "computer readable medium" may include a propagated signal based on Applicants' specification. *See* Office Action, pp. 2-3. In an effort to expedite prosecution, Applicants amend each of independent claims 45 and 56 to recite, *inter alia*, a "computer readable storage device storing a computer program."

Applicants submit that amended claims 45 and 56, and their respective dependent claims 46-55 and 57-76, are statutory and do not cover or preempt any section 101 judicial exception. Applicants accordingly request withdrawal of the section 101 rejection of these claims.

Section 102 rejection based on *Szeto*

The section 102 rejection of claims 1, 24, 42-45 and 77 based on *Szeto* should be withdrawn because *Szeto* fails to anticipate these claims, as now amended. In order to properly anticipate Applicants' claims under section 102, a single prior art reference must disclose each and every element of the claim at issue, either expressly or under principles of inherency. Here, *Szeto* fails to disclose each and every feature of the claims.

Amended independent claim 1 recites a combination including:

> a module for accessing at least one stored personalization item, the stored personalization item being selected by the first or the second chat participant in a non-chat, instant messaging context; [and]

> a module for migrating the accessed personalization item selected in the non-chat, instant messaging context to a chat context, the migrating being based on a mapping of definitions of personalization items in the chat context to definitions of the personalization items in the non-chat, instant messaging context.

Szeto fails to disclose the combination recited in claim 1, including at least the above-noted "migrating" module.

Szeto relates to sharing an instant messaging environment. *See* Abstract. In particular, *Szeto* describes allowing instant messaging users to create instant messaging environments and share those environments among themselves. *See* col. 2, lines 11-21. In *Szeto*'s system, a sending instant messaging application can specify an environment identifier along with a

message. The environment identifier may cause a receiving instant messaging application to implement the environment corresponding to the identifier. *See* col. 2, lines 25-50; Figs. 2, 4.

The Office Action appears to equate *Szeto*'s environment identifiers to "personalization items." Even if *Szeto*'s environment identifiers were considered "personalization items," as currently claimed, the reference nowhere discloses any structure or functionality for migrating those identifiers (or the environments they represent) as required by claim 1. Specifically, *Szeto* fails to disclose migration from a non-chat, instant messaging context to a chat context, where such migrating is based on a mapping of definitions in the chat context to definitions in the non-chat, instant messaging context. Although *Szeto* mentions that the environments are not limited to instant messaging systems and can be applied to "other messaging systems," the reference is silent with regard to "migrating" environments between non-chat, instant messaging systems and other types of systems, such as chat communications system. *See* col. 4, lines 1-17.

For at least the foregoing reasons, *Szeto* fails to disclose each and every feature of amended claim 1. The section 102 rejection of this claim should therefore be withdrawn.

Amended independent claim 24 recites a combination including:

> storing, in a memory accessible to a chat host system, a mapping of definitions of the personalization items in a chat context to definitions of the personalization items in the non-chat, instant messaging context . . . and

> communicating the identified personalization items from the host system to the chat participant system for rendering in a chat application running on the chat participant system, the identified personalization item being migrated, based on the mapping, from the non-chat, instant messaging context to the chat context for rendering in the chat application.

Szeto fails to disclose the combination recited in claim 24, including at least the above-noted "storing" and "communicating" features.

As note above, *Szeto* describes allowing instant messaging users to share environments among themselves. *Szeto*, however, fails to disclose any functionality for storing a "mapping of definitions of the personalization items in a chat context to definitions of the personalization items in the non-chat, instant messaging context," as recited in claim 24. Likewise, the reference is silent with respect to communicating an identified personalization item from a host system to a

chat participant system for rendering in a chat application, where the identified personalization item is <u>migrated, based on the mapping, from the non-chat, instant messaging context to the chat context for rendering in the chat application</u>, as claimed.

Even if *Szeto*'s environment identifiers were considered "personalization items," the reference nowhere discloses any structure or functionality for storing mappings of definitions of those environment identifiers in a chat context to definitions of the identifiers in a non-chat, instant messaging context, as required by Applicants' claim. The reference further fails to disclose migrating the environment identifiers, based on such a mapping, from a non-chat, instant messaging context to a chat context, as claimed.

Because *Szeto* fails to disclose each and every feature of claim 24, the section 102 rejection of this claim, and its dependent claims 42-44, should be withdrawn.

Amended independent claims 45 recites, *inter alia*:

> storing, in a memory accessible to a chat host system, a mapping of definitions of the personalization items in a chat context to definitions of the personalization items in the non-chat, instant messaging context . . . and

> communicating the identified personalization items from the host system to the chat participant system for rendering in a chat application running on the chat participant system, the identified personalization item being migrated, based on the mapping, from the non-chat, instant messaging context to the chat context for rendering in the chat application.

For at least reasons similar to those presented above in connection with claim 24, the section 102 rejection of claim 45 should be withdrawn.

Regarding amended independent claim 77, *Szeto* fails to disclose at least "migrating the stored personalization item from a non-chat, instant messaging context to a chat context, the stored personalization item having a meaning in the non-chat, instant messaging context that is different from a meaning in the chat context," as claimed. Indeed, *Szeto* merely discloses sharing environments among instant messaging users. The reference does not disclose migrating personalization items from a non-chat, instant messaging context to a chat context, as claimed. Because *Szeto* fails to disclose each and every feature of claim 77, the section 102 rejection of this claim should be withdrawn.

Section 102 rejection based on *Liles*

The section 102 rejection of claims 2, 3, 5, 6, 78-81 and 83-89 based on *Liles* is rendered moot by the cancellation of those claims. Furthermore, the section 102 rejection of pending claims 1, 4, 7-12, 14, 15, 17, 18, 20-32, 34, 35, 37-41, 45-48, 50, 51, 53-64, 66, 67, 69 and 71-77 based on *Liles* should be withdrawn because *Liles* fails to anticipate these claims, as now amended.

Liles is directed to animating avatars in a graphic chat session. *See* Abstract. In *Liles*'s system, a user can select an avatar that will represent the user in a chat session. *Liles* discloses that the user can select an animation of the avatar that conveys a desired emotion and/or state of mind to another user in the chat session. *See* col. 3, lines 32-41. As the Office Action notes, *Liles* describes that, in a graphical chat session, a user identifier is added to a participant list when the user joins the chat session. *See* col. 1, lines 50-65.

With regard to independent claim 1, *Liles* fails to disclose at least a module for "migrating" a personalization item selected in a non-chat, instant messaging context to a chat context, where the migrating is based on a mapping of definitions in the chat context to definitions in the non-chat, instant messaging context, as claimed. Even if *Liles*'s person "identifier" were considered a "personalization item," the reference nowhere discloses "migrating" such identifiers selected in a non-chat, instant messaging context to a chat context, as claimed. Likewise, the reference fails to disclose migrating the identifiers based on a "mapping" of definitions, as required by claim 1.

Because *Liles* fails to disclose each and every feature of claim 1, the section 102 rejection of this claim, and its dependent claims 4-12, 14, 15, 17, 18 and 20-23, should be withdrawn.

As to amended independent claims 24 and 45, *Liles* fails to disclose at least the following features:

> storing, in a memory accessible to a chat host system, a mapping of definitions of the personalization items in a chat context to definitions of the personalization items in the non-chat, instant messaging context . . . and

> communicating the identified personalization items from the host system to the chat participant system for rendering in a chat application running on the chat participant system, the identified

> personalization item being migrated, based on the mapping, from
> the non-chat, instant messaging context to the chat context for
> rendering in the chat application.

Liles merely describes selecting and animating avatars in a graphic chat session. The reference does not disclose any functionality for storing a "<u>mapping of definitions</u>" of personalization items in a chat context to definitions of the personalization items in a non-chat, instant messaging context, as claimed. Likewise, *Liles* is silent with respect to communicating an identified personalization item from a host system to a chat participant system for rendering in a chat application, where the identified personalization item is <u>migrated, based on the mapping, from the non-chat, instant messaging context to the chat context for rendering in the chat application</u>, as claimed.

Independent claim 56 recites a combination including:

> rendering at the first chat participant system, a personalization item
> associated with the second chat participant prior to communication
> with the intended second chat participant system, <u>the</u>
> <u>personalization item being selected by the second chat participant</u>
> <u>in a non-chat, instant messaging session, and the rendering of the</u>
> <u>personalization item being based on a stored mapping of</u>
> <u>personalization item definitions from a non-chat, instant messaging</u>
> <u>context to a chat context</u>.

Liles does not disclose any functionality for "rendering" a personalization item, as noted above. Indeed, *Liles* merely describes selecting and animating avatars in a graphic chat session. There is no disclosure in *Liles* of rendering in the graphic chat session a personalization item that is selected in a non-chat, instant messaging session, were such rendering is based on a stored mapping of personalization item definitions from a non-chat, instant messaging context to a chat context.

Regarding independent claim 77, *Liles* fails to disclose at least "migrating the stored personalization item from a non-chat, instant messaging context to a chat context, the stored personalization item having a meaning in the non-chat, instant messaging context that is different from a meaning in the chat context," as claimed. *Liles* describes a graphic chat session, but the reference does not disclose migrating a stored personalization item from a non-chat, instant messaging context to a graphic chat session context.

Because *Liles* fails to disclose each and every feature of claims 24, 45, 56 and 77, the section 102 rejection of these claims, and their respective dependent claims 25-32, 34, 35, 37-41, 46-48, 50, 51, 53-55, 57-64, 66, 67, 69 and 71-76, based on *Liles* should be withdrawn.

Section 103 rejections

Each of claims 13, 16, 19, 33, 36, 49, 52, 65, 68 and 70 depends upon one of claims 1, 24 and 56. For at least the reasons discussed above, *Liles* fails to teach or suggest each and every element in claims 1, 24 and 56. *Grayson*, *Ronen* and *Chase*, which were variously applied in combination with *Liles* to reject dependent claims 13, 16, 19, 33, 36, 49, 52, 65, 68 and 70, all fail to cure the deficiencies of *Liles* with respect to independent claims 1, 24 and 56. Accordingly, the applied art fails to render obvious claim 1, 24 or 56 or their respective dependent claims. The section 103 rejections of dependent claims 13, 16, 19, 33, 36, 49, 52, 65, 68 and 70 should therefore be withdrawn.

The section 103 rejection of claim 82 is rendered moot by the cancellation of that claim.

New claims 90-92

Each of new claims 90-92 depend upon claim 77 and is similarly not anticipated or rendered obvious by the applied art. Applicants accordingly request the timely allowance of new claims 90-92.

Conclusion

Applicants request the Examiner's reconsideration of the application in view of the amendments and foregoing remarks and the timely allowance of the pending claims.

It is believed that all pending issues in the outstanding Office Action have been addressed by this paper. The Office Action, however, contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action. In addition, there may be reasons for patentability of any or all pending or other claims that have not been expressed above.

If there are any questions regarding this paper or the application generally, Applicants would appreciate a telephone call to the undersigned since this may expedite prosecution of the application.

Applicants hereby petition that the period for response to the Office Action be extended for one month. The Petition for Extension of Time fee of $120 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other required charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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